

SN 09/995,304  
Docket No. S-94,769  
In Response to Office Action dated June 15, 2005

#### REMARKS

Applicants appreciate the courtesy shown by the Office, as evidenced by the Office Action mailed on June 15, 2005. In that Office Action, the Examiner rejected Claims 1-14, and objected to Claims 15 and 16. Claims 17-63 have been previously withdrawn. As such, Claims 1-63 remain in the case with none of the claims being allowed.

Applicant also appreciates the courtesy shown by Examiner Pensee Do in the September 13, 2005, telephone interview with Applicants' counsel. In that interview, the rejection of Claim 1 under 35 U.S.C. §102(b) as being anticipated by Miltenyi (U.S. Patent 5,543,289) was discussed. The contents of that interview are reflected in the remarks presented herein.

The October 6 Office Action and September 13 interview have been carefully considered. After such consideration, Claims 1, 14, and 15 have been amended. Applicants respectfully request reconsideration of the application in light of the accompanying amendment and remarks presented herein.

Claims 14 and 15 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that Claim 14 is indefinite "for failing to recite what is immobilized." Accordingly, Claim 14 has been amended to recite the limitation that the magnetic particles are immobilized on a surface. Applicants submit that the amended claim now properly identifies what is immobilized, and the rejection of Claim 14 under 35 U.S.C. §112, second paragraph, is therefore overcome.

The Examiner states that Claim 15 is indefinite for reciting "forming said magnetic microspheres..." because Claim 1 does not recite a step of forming the magnetic microspheres. Accordingly, Claim 15 has been amended to include the step of forming magnetic microspheres that include magnetic particles. Applicants submit that the amendment provides proper antecedent support for "forming said magnetic microspheres..." and the rejection of Claim 15 under 35 U.S.C. §112, second paragraph, is therefore overcome.

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Claims 1-7, and 9-14 have rejected under 35 U.S.C. §102(b) as being anticipated by Miltenyi (U.S. Patent 5,543,289).

Applicants submit that independent Claim 1 has been amended to more clearly describe the present invention. Specifically, Claim 1 has been amended to recite the step of sorting distinct populations of magnetic microspheres by passing the microspheres through a magnetic field to a chamber and a collector, wherein the microspheres are separated according to their magnetic moments. Support for the amendment is found in Figure 1 and on page 11, lines 18-30, of the Specification.

In order to anticipate under §102, a reference must teach each and every aspect of the invention. Accordingly, Applicants submit that Miltenyi does not teach all the limitations of amended Claim 1. As discussed in the September 13 interview, the reference does not teach a method in which magnetic microspheres pass through a magnetic field into a chamber to a collector. Instead, in Figure 1 and column 10, lines 38-47, Miltenyi teaches the introduction of particles into a chamber 11 disposed "between the poles of a magnet 12 (i.e., within a magnetic field)" and filled with a field-intensifying matrix 13 that collects the magnetized particles. The magnetic particles are retained on matrix 13 within the chamber 11 (and, therefore, within the magnetic field), and do not pass through the magnetic field. As the reference states in column 10, lines 45-47: "When the magnetic field is applied, the [magnetic] gradient is created and suitably magnetically labeled samples are *retained in the chamber* (emphasis added)."

Applicants therefore submit that, because the reference does not teach all of the limitations of amended Claim 1, the rejection of the claim and those claims dependent thereon under 35 U.S.C. §102(b) as being anticipated by Miltenyi is therefore successfully overcome.

Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Miltenyi in view of McDevitt et al. (U.S. Patent 6,649,403).

In order to establish a *prima facie* case of obviousness, a reference must either teach or suggest all of the limitations of the claimed invention. Applicants submit that, as previously presented herein, Miltenyi does not teach sorting distinct populations of magnetic microspheres by passing the microspheres through a magnetic field to a chamber and a collector, wherein the microspheres are separated according to their

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magnetic moments. Applicants submit that McDevitt et al. as well does not teach this limitation. Therefore, the rejection of Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Miltenyi in view of McDevitt et al. is successfully overcome.

In light of the amendments and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully request such action. If, however, any outstanding issues remain unresolved, the Examiner is invited to telephone the Applicants' counsel at the number provided below.

Respectfully submitted,

Date: 9/14/2005

  
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